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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,265

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James Edward Angelo

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EXAMINER

FALASCO, LOUIS V

ART UNIT

PAPER NUMBER

1773

MAIL DATE

DELIVERY MODE

09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/642,265	Applicant(s) ANGELO ET AL.	
	Examiner Louis Falasco	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-24,26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Papers Received

1. The Amendment and Remarks filed 7/17/07 are acknowledged.

Claims

2. The claims are: 19 to 26.

Election/Restriction of Invention

3. Claims under consideration remain those drawn to Species A - claims 19 to 24 and 26.

Claim Rejections

Statutory Basis

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections

4. Claims 19, 21-24 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Holmes et al** (WO 99/59036) or **Mentz et al** (US 6017657) or **Nishizaki et al** (US 5550663).

Holmes et al, **Mentz et al** and **Nishizaki et al** all teach a main body with means for embossing sinusoidal shaped recesses of these claims (**Drinkwater** page 9 lns 16-30 and **Mentz et al** col. 9 lns 22-45; **Nishizaki et al** col. 6 lns 36-40). The **Holmes et al**, **Mentz et al** and **Nishizaki et al** embossing means differ merely by the intention to serve as a 'landing zone'. However, these prior art embossing means (tools) would reasonably be expected to meet this limitation since they are in the size range to provide a 'landing zone'. The embossments are sized to diffract a light wavelength (**Holmes et al** page 10 lns 14-16 and **Mentz et al** col. 8 ln 49- col. 11, **Nishizaki et al** col. 3 ln 66- col. 4 ln 6). Adjustments to a size would at most be an obvious matter of routine optimization, changes in size alone is not sufficient to establish patentibility¹.

- As regards claim **21**, sinusoidally protrusions being a negative pattern of positive recesses, this would have been inherent in the **Holmes et al** and **Mentz et al** and **Nishizaki et al** since an embossing relief tool.
- As regards claim **22**, **23** and **24** metal tool, including *Al*- see **Mentz et al** col. 9 lns 17-19. The prior art recognizes the effectiveness of metals in embossing tools, selection of a specific metal would have been *prima facie obvious*, as a matter of selecting know metals based on their suitability for intended use. See MPEP 2144.07.

¹ See MPEP 2144.04, and *In re Rose*, 105 USPQ 237 (CCPA 1955).

- As regards claim 26 spacing 0.1-10µm depth 10-200 Å, this is within a size to diffract a visible light wave in **Holmes et al** and **Mentz et al** and **Nishizaki et al**. At most, this would be a matter of routine optimization or choice - as variations in size alone is not sufficient to establish patentibility. MPEP 2144.04 (at section IV).

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Holmes et al** (WO 99/59036) or **Mentz et al** (US 6017657) or **Nishizaki et al** (US 5550663) as applied to claims 19, 21-24 and 26 above, and further in view of **Belser** (US 6643082).

Holmes et al, **Mentz et al** or **Nishizaki et al** differ from what has been claimed by not stating the embossing tool as means emboss servo and data zones. However, **Belser** points out embossing tools are known for a servo and data zones (**Belser** col. 1 lns 55-61, col. 5 lns 34-41). The limitation that embossing tool will be for embossing servo and data zones can be given little weight since it is an intention and the an embossing tool as claimed would be of a general utility not limited to the intention. A person of ordinary skill in the art would have reasonably expected **Holmes et al** **Mentz et al** or **Nishizaki et al** embossing tool to yield a predictable result size of known for servo and data zone shown by **Belser**. *KRS International Co. v. Teleflex Inc.* 82 USPQ2d 1385.

Examiners comments on allowable subject matter

6. It is note that the claim 23 also includes *Al* with a *NiP* embossing surface as one of the alternatives for the embossing tool. Upon consideration of this limitation, even though not specifically claimed, the examiner points out that no art fairly suggest *NiP* surface *Al* tool. If this were independently claimed, such a claim would be considered allowable.

Other References

7. **Vezenov et al** (US 2002/0168592) is cited as being of interest, but not applied, teaching a stamper with polymeric surface layer.

8. **Aoyama et al** (US 6147732) is cited as being of interest, as cumulative to the primary art teaching sinusoidally negative pattern of recesses to be embossed.

Conclusion

1. The claims are 19 to 26; claim 25 has been withdrawn from consideration. No claim has been allowed.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone

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number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LF
09/07


CAROL CHANEY
SUPERVISORY PATENT EXAMINER